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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/553,397	04/20/2000	Richard R. Reisman	2222.4310009	4230
26111 7590 01/17/2007 STERNE, KESSLER, GOLDSTEIN & FOX PLLC 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER NGUYEN, TANH Q	
			ART UNIT	PAPER NUMBER
			2182	

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	01/17/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 01/17/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

fadkt@skgf.com

## Office Action Summary

### Application No.

09/553,397

### Applicant(s)

REISMAN, RICHARD R.

### Examiner

Tanh Q. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 16-26,28-37 and 39-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-26,28-37 and 39-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 16-26, 28-37, 39-50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The examiner has reviewed the section labeled "Receipt of broadcast data" (page 38, line 22-page 39, line 8) and did not find support for the following limitations:

"capturing and storing the at least one desired data object from the received broadcast data stream based on said information, the at least one desired data object's object identifier contained in the broadcast data stream, and a schedule" - as recited in claims 16 and 28;

"selecting the first one of the plurality of independently operated data sources from a listing of each of the plurality of independently operated data sources" - as recited in claims 20-21, 32;

"wherein the method is performed a plurality of consecutive times, wherein during

each time the method is performed, a user at the user station can access desired data objects that have previously been captured and stored during a prior time the method is performed" - as recited in claim 25; and

'wherein the user station enables a user to access the at least one captured and stored desired data object while the user station receives, captures, and stores additional desired data objects" - as recited in claim 36.

Applicant is required to either remove the new matter, or specifically point out in the disclosure the support for the above limitations - in the reply to this Office Action.

4. Claims 40-42, 46-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Each of the claims recites the limitation "the at least one data object". There is insufficient antecedent basis for the limitation in each of the respective claims.

5. The rejections that follow are based on the examiner's best interpretation of the claims.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 16-19, 23-26, 28-31, 34-37, 39-42, 45-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Joseph et al. (US 5,819,034).

8. As per claims 16-19, 23-26, Joseph teaches a method for operating a user station [20, FIG. 1], comprising:

receiving information to cause the user station to watch for at least one desired data object in a broadcast data stream [col. 12, lines 56-65], the broadcast data stream including the at least one desired data object and at least one other data object [col. 4, lines 33-39], and the at least one desired data object being identified in the broadcast data stream by an object identifier (packet identification information) contained in the broadcast data stream [col. 4, lines 33-39];

receiving the broadcast data stream [via high speed data link 30, FIG. 1], and capturing and storing the at least one desired data object from the received

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broadcast data stream based on said information, the at least one desired data object's object identifier contained in the broadcast data stream [col. 4, line 66-col. 5, line 9], and a schedule [the desired data object in the broadcast data stream being repetitive [col. 3, lines 4-7] and in accordance with schedule [col. 10, lines 20-24]].

Joseph further teaches the at least one desired data object being stored in temporary storage at the user station, fetching the at least one desired data object from the temporary storage, preparing the fetched at least one desired data object for use at the user station [col. 5, lines 5-9];

tuning the user station to receive the broadcast data stream [col. 4, lines 54-56];

the at least one desired data object comprising data to which a user at the user station is entitled [entitlement with a cable system [col. 2, line 26; col. 7, line 9];

the method being performed a plurality of consecutive times, wherein during each time the method is performed, a user at the user station can access desired data objects that have previously been captured and stored during a prior time the method is performed [col. 5, lines 32-44];

a user at the user station selecting the at least one desired data object to be captured and stored [col. 12, lines 56-65].

9. As per claims 28-31, 34-35, 37, the claims generally correspond to claims 16-20, 23-26 and are rejected on the same bases.

10. As per claim 36, Joseph teaches the user station enabling a user to access the at least one captured and stored desired data object while the user station receives, captures, and stores additional desired data objects [col. 5, lines 32-44].

11. As per claims 39-42, 45-46, Joseph teaches capturing and storing the desired data object according to the schedule (see rejection of claim 16 above) and the method being performed a plurality of times (see rejection of claim 25 above), hence repeating the capturing and storing according to the schedule; an updated version of the desired data object [col. 7, lines 25-28]; and optionally purging prior versions of the desired data object by a user [col. 13, lines 37-42].

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 20-21, 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joseph et al..

Joseph teaches the limitations of claims 16 and 28 above. Joseph further teaches the at least one desired data object being received from (or supplied by) a first one of a plurality of independently operated data sources [channel sources 108, 108A - FIG. 2; col. 9, lines 43-51] and selecting the first one of the plurality of independently operated data sources from the plurality of independently operated data sources [col. 12, line 66-col. 13, line 2; col. 4, lines 54-56], and an application programming interface enabling a software application to select the first one of the plurality of independently operated data sources [col. 12, lines 56-65].

Joseph does not specifically teach selecting a first one of the plurality of independently operated data sources from a listing of the plurality of independently operated data sources.

Since it was known at the time the invention was made to list a plurality of independently operated data sources to make it easier for a user to select an independently operated data source, it would have been obvious to one of ordinary skill in the art at the time the invention was made to do so, in order to facilitate the selection by the user.

14. Claims 22, 33 rejected under 35 U.S.C. 103(a) as being unpatentable over Joseph et al, and in the alternative over Joseph et al. in view of Wagner et al. (US 5,761,602).

Joseph teaches the limitations of claims 16 and 28 above. Joseph does not teach the broadcast data stream being broadcast by Internet multicasting. Since applicant discloses the broadcast information distribution system being an alternative to modem-based wireline or wireless calling to a server; and on the Internet, such broadcasting to a selected group of recipients is called multicasting (page 38, lines 22-27), the use of a broadcast information distribution system or Internet multicasting is not significant, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Internet multicasting in order to practice the Joseph's invention in an Internet environment.

Wagner teaches information from the Internet being multicast to subscribers via a router/distributor [FIG. 1] in order to constantly receive the information without incurring



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telephone connection costs [col. 5, lines 65-67]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Wagner's teachings into Joseph, in order to avoid incurring telephone connection costs.

15. Claims 20-21, 32; 43-44, 47-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joseph et al..

Joseph teaches a method for operating a user station [20, FIG. 1], comprising:  
receiving information to cause the user station to watch for at least one desired data object in a broadcast data stream [col. 12, lines 56-65], the broadcast data stream including the at least one desired data object and at least one other data object [col. 4, lines 33-39], and the at least one desired data object being identified in the broadcast data stream by an object identifier (packet identification information) contained in the broadcast data stream [col. 4, lines 33-39];

receiving the broadcast data stream [via high speed data link 30, FIG. 1], and  
capturing and storing the at least one desired data object from the received broadcast data stream based on said information, the at least one desired data object's object identifier contained in the broadcast data stream [col. 4, line 66-col. 5, line 9].

Joseph further teaches repeating the capturing and storing (see rejection of claim 25 above), an updated version of the desired object (see rejection of claim 40 above), and optionally purging prior versions of the desired data object by a user (see rejection of claims 41-42 above).

Joseph also teaches the method including broadcasting a home shopping show [col. 8, lines 22-25]. Since it was known in the art at the time the invention was made

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for a home shopping show to be scheduled as shown on a TV Guide, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a TV Guide to determine when the home shopping show is on to shop, hence capturing and storing the desired data object in accordance with the schedule of the home shopping show.

Furthermore, since it was known in the art at the time the invention was made to use a revised TV Guide to determine when a show is on, hence fetching a revised schedule to determine when the home shopping show is on in order to shop in accordance with the revised schedule for the home shopping show.

### ***Response to Arguments***

16. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection and/or not persuasive.

17. With respect to claims 20-21 and 32

Applicant argued that tuning of television channels and cable television systems necessarily includes selection of one independently operated data source from a listing of a plurality of independently operated data sources provided on a television display screen. The argument is not persuasive because a listing of a plurality of independently operated data sources is not necessary - as a user can select an independently operated data source by entering a channel number or using the channel up/channel down keys.

Applicant further cited page 17, lines 19-22; page 19, lines 8-11 and page 43,

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lines 11-17 to show selection of an object from a list of objects, and relied on *Kolmes vs. World Fibers Corp.* to argue that that the features recited in a claim do not necessarily have to be disclosed in the specification within a single embodiment.

The argument is not persuasive because applicant did not specifically show how *Kolmes vs. World Fibers Corp.* is applicable in the claimed invention. Merely arguing that the features recited in a claim do not necessarily have to be disclosed in the specification within a single embodiment is not sufficient to overcome the rejections.

The argument is also not persuasive because under "Receipt of Broadcast Data" [page 38, line 19-page 39, line 8], there is no disclosure of a selection of an independently operated data source from a list of each of the plurality of independently operated data sources - hence suggesting that applicant did not, at the time the invention was made, contemplate the invention as presently claimed.

Page 17, lines 19-22 discloses selection transportable objects from a predefined list, but does not disclose any broadcasting. Furthermore, the selection in the rejected claims is directed to a selection of data sources, not the transportable object (i.e. desired data object).

Page 17, lines 8-11 discloses selection of an appropriate file transfer protocol from a list, but does not disclose any broadcasting. It is not clear how the file transfer protocol relates to the selection of a data source for a broadcast data stream.

Page 43, lines 11-17 discloses selection a protocol mapper from a list, but does not disclose any broadcasting. It is not clear how the protocol mapper relates to the selection of a data source for a broadcast data stream.

18. With respect to claims 25, 36, applicant cited page 12, lines 15-25 to show the limitations of the claims, and relied on *Kolmes vs. World Fibers Corp.* to argue that that the features recited in a claim do not necessarily have to be disclosed in the specification within a single embodiment.

The argument is not persuasive because did not specifically show how *Kolmes vs. World Fibers Corp.* is applicable in the claimed invention. Merely arguing that the features recited in a claim do not necessarily have to be disclosed in the specification within a single embodiment is not sufficient to overcome the rejections.

Furthermore, it is not clear how the cited section support the limitations of the claims. At best understood, the cited section merely supports data update - therefore at most that the method is performed a plurality of times, and nothing else. The cited section does not disclose any broadcasting.

It is also not clear how the update relates to performing the method and accessing data objects previously captured in a broadcast environment. The evidence presented, is not sufficient to suggest that applicant, at the time the invention was made, contemplated the invention as presently claimed.

19. With respect to claims 16 and 28, applicant cited page 16, line 27; page 21, lines 12-13; page 23, lines 19-21 for "capturing and storing the at least one desired data object...based on...a schedule".

The argument is not persuasive because the cited sections appear to be directed to automatic scheduling and schedule deferral, but does not disclose any scheduling

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activity in conjunction with capturing and storing the desired data object based on information causing a user station to watch for a desired data object and based on the object identifier of the desired data object. Furthermore, the cited section does not disclose a desired data object in a broadcast data stream. It is therefore not clear how the cited section support the limitations of the claims.

The argument is further not persuasive because page 39, lines 7-8 discloses "A schedule transport function can then be set to fetch the received data objects from temporary storage and prepare them for use", suggesting that the scheduling occurs after the desired data object is captured and stored in temporary storage - hence the capturing and storing not being based on a schedule.

### ***Conclusion***

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tanh Q. Nguyen whose telephone number is 571-272-4154. The examiner can normally be reached on M-F 9:30AM-7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Huynh can be reached on 571-272-4147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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